

REMARKS

The Examiner has maintained his rejection of claims 1-5, 7-14, 58-61 and 67 as obvious over Lapeyre in view of Furuata (US 5,943,043), and his further rejection of claim 6 as obvious over these references as combined with Ahmadian. Applicants respectfully submit that the Examiner has mischaracterized the Furuata reference as disclosing more than it does, and respectfully request reconsideration of these rejections in light of the following remarks.

Claim 1, from which all pending claims depend, specifically features "providing provisional output to a user ... [and then,] in response to activation of the adjacent key region prior to release of the first activated key region, providing a final output to the user to the exclusion of the provisional output." Thus, the claims feature a combination of two outputs to the user, first a provisional output and then a final output. In other words, the invention as recited in claim 1 features, in the context of a keyboard, a feedback sequence of two outputs.

In short, there is nothing in any of these three cited references that discloses or suggests such a feedback sequence, in a keyboard or otherwise.

In response to Applicants' remarks submitted in response to the first substantive rejection of these claims, the Examiner says of Furuata that:

Furuata, in the Abstract and the Figures 1A-1C, discloses activating a first key region to provide a provisional output, activating an adjacent key region prior to release of the first activated key region, and providing a final output to the user in response to the activation of the adjacent key region prior to release of the first activated key region. (Final Office Action, p. 4)

The Examiner does not expressly acknowledge, however, that the "output" discussed in Furuata is not output to the user, but coordinate data fed from the display screen or touch panel to its associated device. See, e.g., Furuata column 4, lines 14-22. In fact, there is nothing in Furuata that gives any indication that a user of his touch screen would necessarily receive any provisional feedback, from activation of a first region, that is replaced by feedback in response to activation of a second region while still activating the first region.

Thus, Applicants respectfully submit that the cited references do not, singularly or as combined, present a prima facie case of obviousness against the rejected claims. Should the Examiner maintain this rejection, Applicants ask that he include a detailed explanation, including column and line numbers, of where such a feedback sequence is found in the cited references.

Furthermore, Applicants submit that the combination of Furuhashi with Lapeyre to reject claim 1 is improper, as Furuhashi is non-analogous art. The courts have made it very clear that each cited reference must meet a two-step test to determine if it is analogous art and therefore properly asserted in an obviousness rejection. The first step is to determine whether the reference is "within the field of the inventor's endeavor".¹ If not, the reference may still be pertinent if it is "reasonably pertinent to the particular problem with which the inventor was involved."²

The inventors define the field of endeavor, by their specification and claims.³ In this case, the specification begins: "This invention relates to tiled keyboards with keys that provide unique outputs as a consequence of both individual keys and with the actuation of adjacent keys associated with an interstice, and to the interpretation of data entered on such keyboards."⁴ The claims in issue all begin their preambles: "A method of providing input feedback in a device having a keyboard with a matrix of interstitial key regions and raised independent key regions".

Furuhashi clearly fails the first test as being outside the field of the inventors' endeavor. Moreover, Furuhashi also fails the second test, as it is not a prior art reference which, "because of the matter with which it deals, would have commended itself to an inventor's attention in considering his problem."⁵ It is improper to define the "problem" broadly, in hindsight, in order to legitimize an improper reference citation.⁶ A reference directed to a different purpose than the invention would have provided less motivation or occasion to an inventor to have considered it.⁷

¹ In re Deminski, 796 F.2d 436, 23 USPQ 313 (Fed. Cir. 1986).

² Id.

³ In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

⁴ Specification, p. 1, line 6.

⁵ In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

⁶ To illustrate an example of an improperly broad problem formulation, Applicants note that the Court in In re Clay held that "A person having ordinary skill in the art would not reasonably have expected to solve the problem

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Should the Examiner maintain the rejection of the claims over any combination including Furuhashi, he is asked to clearly state, for the record, how one of ordinary skill would have looked to Furuhashi for help in solving the problem addressed by Applicants regarding feedback in keyboard operation.

Applicants would also appreciate the opportunity for a telephone interview, between the Examiner and undersigned attorney, to resolve any issues still preventing allowance of the pending claims, after receipt and consideration of this submission.

No fees are believed due, other than the fee submitted with the enclosed Request for Continued Examination. Please apply any charges or credits to deposit account 06-1050, referencing the above attorney docket number.

Respectfully submitted,

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of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies."